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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,527	12/02/2005	Mitsutoshi Shinkai	SON-3029	2726
23353 7590 01/26/2010 RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036			EXAMINER YODICHKAS, ANEETA	
			ART UNIT 2627	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/559,527

**Applicant(s)**

SHINKAI ET AL.

**Examiner**

Aneeta Yodichkas

**Art Unit**

2627

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4,5 and 7-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,5 and 7-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claim 12** is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Pub. No. 2002/0097645 A1 to *Mikawa*.

As to **claim 12**, *Mikawa* discloses a recording medium having recorded thereon data that is played back by an information processing apparatus that manages data wherein a first file including an identifier for identifying a format on the recording medium, the first file serving to manage data in the format, and a second file including an identifier that is the same as the identifier, the second file further including label information describing content of data in the format, are recorded in the format as mutually different files on the recording medium (Fig. 4 and 5, paragraphs 0090-0111), where the first file identifier is the content identification information and creation TOD information on the inserted disc (D), the second file identifier is the content identification information and the creation TOD information read from HDD (409) and are mutually different files.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 7-11 and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Pub. No. 2002/0097645 A1 to *Mikawa* in view of U.S. Patent No. 6,937,553 B1 to *Mitui et al.*

As to **claim 1**, *Mikawa* discloses an information processing apparatus for managing data that is recorded on a recording medium, the information processing apparatus comprising: copying means for copying an identifier for identifying a format that is managed by a first file for managing information recorded on the recording medium, the identifier being included in the first file (Fig. 2 and 3, paragraph 0076,), where the copy management processor (207) provides the copying means for copying content identification information and the first file is disc 1 (D1); creating means for creating a second file including the identifier copied by the copying means and label information describing content of the data further comprising a setting means for setting the label information (Fig. 2 and 3, paragraphs 0063, 0076), where second file is disc 2 (D2) and the content identification information is copied onto D2 and the TOD information is the label information; wherein the creating means creates the second file including the identifier copied by the copying means and the label information set by the setting means (Fig. 2 and 3, paragraphs 0063, 0076), where second file is disc 2 (D2) and the content identification information is copied onto D2 and the TOD information is the label information, and wherein said label information includes information regarding a representative frame image representing all the frame images of image data included

in the recording medium (Fig. 7, paragraph 0087), where the file management information is the label which includes the information representative of the frames; and recording means for recording the second file created by the creating means in the format identified by the identifier on the recording medium, as a file that is different from the first file (Fig. 4 and 5, paragraphs 0090-0111), where the first file on disk (D), which is the content ID information and the creation TOD information from the disk management information, is compared with the information in the database of HDD (409) and if they are different, the new information from disk (D) is updated by recording in the database of HDD (409), which creates a second file; and a comparing means for comparing an identifier included in the second file with an identifier included in the first file recorded onto the recording medium (Fig. 4 and 5, paragraph 0110), where database management unit (405) compares the update TOD information of the disk management information with the update TOD information read from the disk D.

*Mikawa* is deficient in disclosing wherein the recording means records the second file in the format identified by the identifier on the recording medium only when it is determined as a result of comparison by the comparing means that the identifier included in the second file matches with the identifier included in the first file.

However, *Mitui* discloses the recording means records the second file in the format on the recording medium only when it is determined as a result of comparison by the comparing means that the identifier included in the second file matches with the identifier included in the first file (Fig. 14, columns 12-13, lines 44-7), where the detected area code is compared with the area code acquired from the reproduction

apparatus in step (s802) and if they match, as well as the copy attribute with the medium ID information in step (s809), where the area code and ID information are the identifies, reproduction of the duplicate is performed, which is the second file.

At the time of invention, it would have been obvious to a person of ordinary skilled in the art to have modified the information processing apparatus for managing data that is recorded on a recording medium as taught by *Mikawa* by including recording a second file only when it is determined that the second file matches with the identifier of the first file as taught by *Mitui*. The suggestion/motivation would have been in order to insure that both discs formats are of the same type from the same region before performing recording (Fig. 14, column 12, lines 43-55).

As to **claim 7**, *Mikawa* discloses the information processing apparatus comprising: reading means for reading the second file from the recording medium (Fig. 6 and Fig. 7, paragraphs 106-107); and updating means for updating the label information included in the second file read by the reading means (Fig. 2, paragraph 47); wherein the comparing means compares an identifier included in the second file whose label information has been updated by the updating means with an identifier included in the first file recorded on the recording means (Fig. 4 and Fig. 7, paragraphs 96-99), and wherein the recording means records the second file in the format on the recording medium only when it is determined as a result of comparison by the comparing means that the identifier included in the second file coincides with the identifier included in the first file (Fig. 4 and Fig. 7, paragraphs 96-99).

As to **claim 8**, *Mikawa* discloses the information processing apparatus wherein the recording medium is an optical disc (Paragraph 140).

As to **claim 9**, *Mikawa* discloses the information processing apparatus wherein the recording medium is a semiconductor memory (Paragraph 140).

As to **claim 10**, *Mikawa* discloses an information processing method for an information processing apparatus that manages data that is recorded on a recording medium, the information processing method comprising: a copying step of copying an identifier for identifying a format that is managed by a first file for managing information recorded on the recording medium, the identifier being included in the first file (Fig. 3, paragraphs 62-70); a creating step of creating a second file including the identifier copied by processing in the copying step and label information describing content of the data, further comprising a setting step for setting the label information (Fig. 2 and 3, paragraphs 0063, 0076), where second file is disc 2 (D2) and the content identification information is copied onto D2 and the TOD information is the label information; wherein the creating step creates the second file including the identifier copied by the copying step and the label information set by the setting step (Fig. 2 and 3, paragraphs 0063, 0076), where second file is disc 2 (D2) and the content identification information is copied onto D2 and the TOD information is the label information, and wherein said label information includes information regarding a representative frame image representing all the frame images of the image data included in the recording medium (Fig. 7, paragraph 0087), where the file management information is the label which includes the information representative of the frames; and a recording controlling step of exercising

control so that the second file created by processing in the creating step is recorded in the format identified by the identifier on the recording medium, as a file that is different from the first file (Fig. 4 and 5, paragraphs 0090-0111), where the first file on disk (D), which is the content ID information and the creation TOD information from the disk management information, is compared with the information in the database of HDD (409) and if they are different, the new information from disk (D) is updated by recording in the database of HDD (409), which creates a second file; and a comparing means for comparing an identifier included in the second file with an identifier included in the first file recorded onto the recording medium (Fig. 4 and 5, paragraph 0110), where database management unit (405) compares the update TOD information of the disk management information with the update TOD information read from the disk D.

*Mikawa* is deficient in disclosing wherein the recording means records the second file in the format identified by the identifier on the recording medium only when it is determined as a result of comparison by the comparing means that the identifier included in the second file matches with the identifier included in the first file.

However, *Mitui* discloses wherein the recording means records the second file in the format on the recording medium only when it is determined as a result of comparison by the comparing means that the identifier included in the second file matches with the identifier included in the first file (Fig. 14, columns 12-13, lines 44-7), where the detected area code is compared with the area code acquired from the reproduction apparatus in step (s802) and if they match, as well as the copy attribute with the medium ID information in step (s809), where the area code and ID information



are the identifies, reproduction of the duplicate is performed, which is the second file. In addition, the same motivation is used as the rejection in claim 1.

As to **claim 11**, *Mikawa* discloses a program for allowing a computer to execute processing for managing data that is recorded on a recording medium, the processing comprising: a copying step of copying an identifier for identifying a format that is managed by a first file for managing information recorded on the recording medium, the identifier being included in the first file (Fig. 3, paragraphs 62-70); a creating step of creating a second file including the identifier copied by processing in the copying step and label information describing content of the data, further comprising a setting step for setting the label information (Fig. 2 and 3, paragraphs 0063, 0076), where second file is disc 2 (D2) and the content identification information is copied onto D2 and the TOD information is the label information; wherein the creating step creates the second file including the identifier copied by the copying step and the label information set by the setting step (Fig. 2 and 3, paragraphs 0063, 0076), where second file is disc 2 (D2) and the content identification information is copied onto D2 and the TOD information is the label information, and wherein said label information includes information regarding a representative frame image representing all the frame images of the image data included in the recording medium (Fig. 7, paragraph 0087), where the file management information is the label which includes the information representative of the frames; and a recording controlling step of exercising control so that the second file created by processing in the creating step is recorded in the format identified by the identifier on the recording medium, as a file that is different from the first file (Fig. 4 and 5,

paragraphs 0090-0111), where the first file on disk (D), which is the content ID information and the creation TOD information from the disk management information, is compared with the information in the database of HDD (409) and if they are different, the new information from disk (D) is updated by recording in the database of HDD (409), which creates a second file; and a comparing means for comparing an identifier included in the second file with an identifier included in the first file recorded onto the recording medium (Fig. 4 and 5, paragraph 0110), where database management unit (405) compares the update TOD information of the disk management information with the update TOD information read from the disk D.

*Mikawa* is deficient in disclosing wherein the recording means records the second file in the format identified by the identifier on the recording medium only when it is determined as a result of comparison by the comparing means that the identifier included in the second file matches with the identifier included in the first file.

However, *Mitui* discloses wherein the recording means records the second file in the format on the recording medium only when it is determined as a result of comparison by the comparing means that the identifier included in the second file matches with the identifier included in the first file (Fig. 14, columns 12-13, lines 44-7), where the detected area code is compared with the area code acquired from the reproduction apparatus in step (s802) and if they match, as well as the copy attribute with the medium ID information in step (s809), where the area code and ID information are the identifies, reproduction of the duplicate is performed, which is the second file. In addition, the same motivation is used as the rejection in claim 1.

As to **claim 13**, *Mikawa* discloses the information processing apparatus, wherein the first file includes both an identifier and a table including clip information and edit information (Fig. 6 and 7, paragraphs 0086-0087), where the file is the file management information and it includes a list or table of clip or file type, name, path, size and time information.

**Claims 4 and 5** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Pub. No. 2002/0097645 A1 to *Mikawa* in view of U.S. Patent No. 6,937,553 B1 to *Mitui et al.* in further view of U.S. Patent Pub. No. 2002/0154898 A1 to *Hisatomi et al.*

As to **claim 4**, *Mikawa* and *Mitui* are deficient in disclosing the information processing apparatus wherein the setting means selectively sets the representative frame image from representative frame images of respective clips recorded on the recording medium.

However, *Hisatomi* discloses the information processing apparatus wherein the setting means selectively sets the representative frame image from representative frame images of respective clips recorded on the recording medium (Fig. 3 and 4, paragraphs 65-0068), where each frame image, or the video object set (80) of the audio video data area (76) are set according to the desired data recorded.

At the time of invention, it would have been obvious to a person of ordinary skilled in the art to have created an information processing apparatus for managing data that is recorded on a recording medium as taught by *Mikawa* and *Mitui* by including that it has a creating means for creating a second file and a setting means for selecting sets for the representative frame image as taught by *Hisatomi*. The suggestion/motivation

would have been in order to be able to search or edit an image easily as taught by *Hisatomi* (*Hisatomi*, paragraph 65).

As to **claim 5**, *Mikawa* and *Mitui* are deficient in disclosing the setting means sets a beginning frame image of a beginning clip as the representative frame image when no instruction for setting the representative frame image is given

However, *Hisatomi* discloses the setting means sets a beginning frame image of a beginning clip as the representative frame image when no instruction for setting the representative frame image is given (Fig. 3, paragraph 63-64). In addition, the same motivation is used as the rejection for claim 4.

#### ***Response to Arguments***

Applicant's arguments filed 10/2/09 have been fully considered but they are not persuasive.

First, Applicant argues, with respect to claim 12, on pages 7-9, lines 8-11, that *Mikawa* fails to disclose, "wherein a first file including an identifier for identifying a format on the recording medium, the first file serving to manage data in the format, and a second file including an identifier that is the same as the identifier, the second file further including label information describing content of the data in the format, are recorded in the format as mutually different files on the recording medium", specifically, "a first file including an identifier for identifying a format and a second file including an identifier that is the same as the identifier are recorded in the format as mutually different files on the recording medium".

Examiner disagrees as *Mikawa* discloses, "a first file including an identifier for identifying a format and a second file including an identifier that is the same as the identifier are recorded in the format as mutually different files on the recording medium" (Fig. 4 and 5, paragraphs 0090-0111), where the first file identifier is the content identification information and creation TOD information on the inserted disc (D), the second file identifier is the content identification information and the creation TOD information read from HDD (409) and are mutually different files.

Second, Applicant argues, with respect to claims 1, 7-11 and 13, on pages 9-12, lines 12-13 and 20-28, that *Mikawa* and *Mitui* fail to disclose, "recording means for recording the second file created by the creating means in the format identified by the identifier on the recording medium, as a file that is different from the first file" and "a comparing means for comparing an identifier included in the second file with an identifier included in the first file recorded onto the recording medium, wherein the recording means records the second file in the format identified by the identifier on the recording medium only when it is determined as a result of comparison by the comparing means that the identifier included in the second file matches with the identifier included in the first file".

Examiner disagrees as *Mikawa* discloses, "recording means for recording the second file created by the creating means in the format identified by the identifier on the recording medium, as a file that is different from the first file" (Fig. 4 and 5, paragraphs 0090-0111), where the first file on disk (D), which is the content ID information and the creation TOD information from the disk management information, is compared with the

information in the database of HDD (409) and if they are different, the new information from disk (D) is updated by recording in the database of HDD (409), which creates a second file. Examiner also disagrees as *Mitui* discloses "a comparing means for comparing an identifier included in the second file with an identifier included in the first file recorded onto the recording medium, wherein the recording means records the second file in the format identified by the identifier on the recording medium only when it is determined as a result of comparison by the comparing means that the identifier included in the second file matches with the identifier included in the first file" (Fig. 14, columns 12-13, lines 44-7), where the detected area code is compared with the area code acquired from the reproduction apparatus in step (s802) and if they match, as well as the copy attribute with the medium ID information in step (s809), where the area code and ID information are the identifies, reproduction of the duplicate is performed, which is the second file. For the reasons stated above, claims 7-9 and 13 are not patentable.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Third, Applicant argues, with respect to claims 4 and 5, on pages 12-14, that *Mikawa*, *Mitui*, and *Hisatomi* fail to disclose, a setting means that selectively sets the representative frame image from representative frame images of the respective clips recorded on the recording medium. Applicant also argues that *Mikawa*, *Mitui*, and *Hisatomi* fail to disclose "wherein the recording means recordings the second file in the format identified by the identifier on the recording medium only when it is determined as a result of comparison by the comparing means that the identifier included in the second file matches with the identifier included in the first file" and a copying means for copying an identifier for identifying a format that is managed by a first file, recording means for recoding the second file created by the creating means in the format identified by the identifier, or a comparing means for comparing an identifier included in the second file with an identifier included in the first file, wherein the recording means records the second file in the format identified by the identifier on the recording medium only when it is determined that the identifier included in the second file matches with the identifier included in the first file.

Examiner disagrees as *Hisatomi* discloses, a setting means that selectively sets the representative frame image from representative frame images of the respective clips recorded on the recording medium (Fig. 3 and 4, paragraphs 65-0068), where each frame image, or the video object set (80) of the audio video data area (76) are set according to the desired data recorded. Examiner disagrees that *Mikawa*, *Mitui*, and *Hisatomi* fail to disclose "wherein the recording means recordings the second file in the format identified by the identifier on the recording medium only when it is determined as

a result of comparison by the comparing means that the identifier included in the second file matches with the identifier included in the first file” and a copying means for copying an identifier for identifying a format that is managed by a first file, recording means for recoding the second file created by the creating means in the format identified by the identifier, or a comparing means for comparing an identifier included in the second file with an identifier included in the first file, wherein the recording means records the second file in the format identified by the identifier on the recording medium only when it is determined that the identifier included in the second file matches with the identifier included in the first file for the reasons stated above.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aneeta Yodichkas whose telephone number is (571)



272-9773. The examiner can normally be reached on Monday-Thursday 8-5, alternating Fridays, 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joseph H. Feild/  
Supervisory Patent Examiner, Art  
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/A.Y./  
1/15/10